

REMARKS

Claims 1-54 are pending after this amendment.

Applicant has amended claims 6-8, 26-28 and 43-45 in order to more particularly define the invention. The amendments were not necessitated by the claim rejections. Applicant makes no admission as to the patentability or unpatentability of the originally filed claims.

The amendments and remarks presented herein are in response to the Office Action dated March 29, 2006. Applicant thanks Examiner for the determination that the declaration filed on November 14, 2005 under 37 CFR 1.131 was sufficient to overcome the rejections in view of the Checkfree reference.

Examiner rejected claims 1-54 under 35 U.S.C. § 103(a) as being unpatentable over Dunn in view of Kreminic. Applicant respectfully traverses. Applicant thanks Examiner for examination of the claims pending in this application and addresses Examiner's comments below.

With regard to the Examiner's statement that any argument against the Kreminic reference "is also an argument against said declaration," Applicant respectfully disagrees. The determination of whether the claimed invention is obvious in view of Kreminic and Dunn is a separate question from whether the declaration is sufficient evidence of conception and reduction to practice. The Examiner has already concluded that the declaration antedates the Checkfree reference. Now, the inquiry is whether the combination of Kreminic and Dunn is

sufficient to anticipate the claimed invention under 35 U.S.C. § 103(a). The Applicant respectfully maintains it is not.

The Examiner, the undersigned attorney, and attorney Amir Raubvogel held a telephone interview on May 31, 2006. The substance of these communications is set forth herein. On May 31, 2006, the Examiner and attorneys for Applicant discussed claim 1 and dependent claim 6 (claim 6 is currently amended to independent form). The Examiner recognized that he previously relied on Dunn and Kreminic in the Office Action mailed on August 9, 2002. The references were discussed in an earlier interview in 2002, summarized in Applicant's response mailed November 7, 2002. As the interview summary from 2002 discusses, the Examiner previously agreed that the combination of Kreminic and Dunn is insufficient to anticipate Applicant's disclosure under §103(a).

Despite the Examiner's decision to conduct a new search, use new references, and not rely on Kreminic or Dunn for almost four years, Kreminic and Dunn have resurfaced in the current Office Action. As discussed below, Kreminic and Dunn are still insufficient to form the basis for the rejections under §103(a).

REJECTION OF CLAIMS 1-54 UNDER §103(A)

The Examiner has rejected all of the Applicant's 54 claims without providing any explanation as to how the cited art applies to the elements of these claims. Because of the many distinct features of these claims, the Examiner's omnibus rejection is improper. See M.P.E.P § 707.07 (d) ("A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally

applicable to all claims in the group.”) For this reason, Applicant respectfully requests that the Examiner clarify the grounds for rejecting these claims, or alternatively withdraw the rejections. Despite this improper grouping of the claims, Applicant attempts to address the references to advance the prosecution of this application to allowance.

Three requirements must be met for a *prima facie* case of obviousness. First, the prior art references must teach all the limitations of the claims. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. Third, a reasonable expectation of success is required.

THE REFERENCES DO NOT TEACH ALL THE CLAIM LIMITATIONS

Kreminic and Dunn do not teach all the limitations of the claims. With regard to claims 1, 6 and 15, as the Examiner correctly acknowledges, Dunn does not discuss matching a transaction from a first list to a subset of transactions from a second list. With regard to claim 14, Dunn also does not discuss the matching of multiples or combinations (many-to-many). Dunn describes only one-to-one matching.

Kreminic does not remedy these deficiencies. With regard to claims 1, 6 and 15, Kreminic only states that “this software allows matching multiple transactions to a summary transaction, thereby reducing the number of unmatched items that require research.” At most, Kreminic discusses the software’s desired outcome, not any techniques to obtain the outcome. There is no description whatsoever of particular steps, methodology, or architecture for achieving these goals. Specifically,

there is no discussion of a system or method for reconciling a first transaction in a first list with a combination of at least two transactions in a second list.

Moreover, the article does not provide screenshots, code or any sort of documentation as to what the software could or could not accomplish or how any such operations were performed when the article was published. It is not clear where the system was in its development at the time the article was published. The article indicates that the system was still in the process of being developed: "In the future, we intend to expand the capabilities of this system for maintaining and controlling various suspense [sic] accounts." Kreminic simply does not disclose what the system could do or how it operated when the article was published.

Furthermore, such details are not the proper subject of official notice of facts not in the record or "common knowledge", as discussed in MPEP 2144.03. As such, the Examiner's statement that "search/matching algorithms are old and well-known in the art and have been explained and discussed for [sic] in text books as one of the fundamental coding principles" cannot be used as evidence of obviousness.

In addition, claims 6 and 15 contain detailed descriptions of how the method reconciles one-to-many transactions; this discussion is not present in either Dunn or Kreminic. The Examiner has not shown where the numerous elements of these claims are found in the references.

The Examiner states that the Kreminic article teaches "one-to-many and many-to-many searching/matching algorithms." This is not clear from the Kreminic article. Kreminic simply does not disclose how the matching is carried out. Claim

14 recites specific steps and elements for performing the reconciliation, many of which are not disclosed by Kreminic. For example, claim 14 recites such specific steps as “combining the obtained transactions to generate first value”, “determining whether the first value corresponds to a combination of the values of a subset of transactions in the second list”, and “responsive to the first value corresponding to the combination of values, indicating a match between the first combination and the subset of transactions.” None of these specific steps and limitations is taught by Kreminic. Rather, Kreminic discloses little more than the desired goal of performing many-to-many item matching, without any indication of how such a goal is accomplished or what steps were performed by the software at the time the article was written.

The dependent claims also recite additional features and limitations that are not taught or suggested by Dunn or Kreminic. The claims that are dependent on claims 1, 6, and 15 specify how to perform the method in great detail.

For example, there is no hint or suggestion of any recursive submethod for determining whether a value of a first transaction corresponds to a combination of values of a subset of transactions in a second list, as recited in claims 10 and 30. Claims 10 and 30 describe a specific matching method that employs a submethod using a first input parameter including a first value and a second input parameter including a second list of values to determine whether the first value corresponds to a combination of values from the second list. Kreminic provides no such disclosure.

In fact, the word “recursive” never appears anywhere in Kreminic. Rather, Kreminic only mentions software that allows “matching multiple transactions to a summary transaction, thereby reducing the number of unmatched items that require research.” No recursive method or submethod is described. Kreminic completely fails to disclose the ability of a recursive method to call itself. Merely performing a task more than once (repetition, or multiple passes) is not equivalent to recursion.

With respect to claims 3, 19, 23, 38 and 42, Kreminic makes no hint or suggestion of any multiple pass technique (whether recursive or not) that operates in the context of an aggregate or one-to-many or many-to-many matching method. Kreminic also fails to mention any method for adding values of transactions or generating a sum of values of transactions.

With respect to claims 7, 27, 44, 8, 28, and 45, Kreminic does not teach obtaining a second list of transactions having dates identical to a date of a first transaction (or having dates within a specified time period of the date of the first transaction), and then determining whether the value of the first transaction corresponds to a value of a transaction in the second list, as claimed herein. Kreminic only states that reconciliation can be handled “by variable criteria established by the reconciliation staff”, examples of which are “posting date” or “available date.”

With respect to claims 9 and 29, Kreminic merely mentions matching items on a given set of criteria. There is no hint or suggestion of modifying a specified time period and repeating matching steps. Furthermore, there is no mention of applying

such a technique in the context of determining and indicating a match between a first transaction and a subset of transactions.

Claims 11, 12, 16, 17, 31, 32, 35, 36, 46, 47, 48, 51, and 52 specifically recite recursive methods, and further recite particular steps for implementing and performing these recursive methods (including conditions for a submethod to call itself). There are any number of methods that can be used for performing one-to-many reconciliation, including some that may involve recursive methodologies and some that may not. As discussed above, Kreminic fails to even mention recursion or recursive methods. In addition, as mentioned above, Kreminic fails to disclose the ability of a recursive method to call itself. Therefore, Kreminic simply does not anticipate or make obvious the particular recursive methodology recited in the claims.

Claims 20, 21, 26, 33, 34 and 39 are computer program product claims that recite similar limitations to those discussed above with respect to the method claims. Claims 40, 43, 49, 50, and 54 are system claims that recite similar limitations to those discussed above with respect to the method claims. Accordingly, for the reasons stated above, Applicant respectfully submits that claims 1, 6, 14, 15, 20, 21, 26, 33, 34, 39, 40, 43, 49, 50, and 54 are patentably distinct from Dunn and Kreminic.

Claims 2-5 and 10-13 are dependent claims that incorporate all of the limitations of claim 1. Claims 7-9 are dependent claims that incorporate all of the limitations of claim 6. Claims 16-19 are dependent claims that incorporate all of the limitations of claim 15. Claims 22-25 and 30-32 are dependent claims that

incorporate all of the limitations of claim 21. Claims 27-29 are dependent claims that incorporate all of the limitations of claim 26. Claims 35-38 are dependent claims that incorporate all of the limitations of claim 34. Claims 41-42 and 46-48 are dependent claims that incorporate all the limitations of claim 40. Claims 44-45 are dependent claims that incorporate all of the limitations of claim 43. Claims 51- 53 are dependent claims that incorporate all of the limitations of claim 50.

Therefore, for at least the reasons stated above, Applicant respectfully submits that the dependent claims are patentably distinct from Dunn and Kreminic.

THERE IS NO SUGGESTION TO COMBINE THE REFERENCES

As a separate ground for traversing the rejection under 35 U.S. C. § 103, Applicant notes that there is no suggestion to combine Dunn and Kreminic. As discussed above, neither reference makes any mention of the terms “recursive” or “recursion” at all. As such, there is no guidance in the references as to how to combine the teachings of Kreminic and Dunn.

The Examiner must show “reasons that the skilled artisan, confronted with the same problem as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d at 1458, 1453 (Fed. Cir. 1998). Thus, the motivation to combine must be particularized, and the required evidence cannot be substituted with a generalized goal, as the Examiner has done in the present case.

In the absence of some teaching or suggestion in the cited references concerning the method of the present invention, the Examiner has presented no

more than an improper hindsight reconstruction of the present invention. As stated by the Court of Appeals for the Federal Circuit *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988): "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The Examiner has stated that the suggested modification would have been within the ordinary skill in the art. MPEP § 2143.01 states "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

In conclusion, the cited references do not disclose all the limitations of the claims, and there is no motivation to combine the references as suggested by the Examiner. Accordingly, a *prima facie* case of obviousness has not been made. Therefore, withdrawal of this ground of rejection is respectfully requested.

On the basis of the above amendments and remarks, consideration of this application and the early allowance of all claims herein are requested. Should the Examiner wish to discuss the above amendments and remarks, or if the Examiner believes that for any reason direct contact with Applicant's representative would

help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,
David R. Larsen

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By: Brenda M. Simon
Brenda M. Simon
Reg. No. 48,449
Fenwick & West LLP
801 California Street
Mountain View, CA 94306
Phone: (650) 335-7198
Fax: (650) 938-5200